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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/762,232

Filing Date: February 05, 2001

Appellant(s): MIGNAULT, LORRAINE

Michael R. Williams
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 8, 2006 appealing from the Office action mailed November 17, 2004.

(1) (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent 4,690,818 Puchalski et al. September 1, 1987

US Patent 5,055,189 Ito October 8, 1991

US Patent 5,397,497 Jakobson et al. May 14, 1995

Susun W. Weed, "Wise Woman, Herbal healing wise", 1989, ISBN: 0-9614620-2-7, pp 192-205

Patrasenko et al. RU 2085296 1997, abstract, DWPI AN 1998-143751.

(9) Grounds of Rejection

1. Claims 1, 5-9, 17-20, 22, 24-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weed (of record) in view of Puchalski, Jr. et al. (of record) and Jakobson et al. (of record), in further view of Ito (US 5,055,189), or Patrasenko et al.
2. Weed teaches hot water extraction of oatstraw (see page 205). The extracts are in the form of oatstraw baths. Weed states "use an oatstraw footbath to soak away stink, sweat, cold, and pain from your tender tootsies," (page 205). For purposes of examination, water as disclosed by Weed is considered to be equivalent to "filtered and magnetized water" as claimed in claim 2. Weed teaches the use of aqueous extracts of oatstraw applied externally to treat pain from any internal distress, including uterine pain. For purposes of examination, uterine pain is considered to meet the limitation of menstrual cramps. Weed also teaches the use of the extract for treating skin diseases, flaky or dry skin, wound, and eye irritations. A bath composition meets the limitation of body wash. Weed further teaches that it is well known that oat straw provide many health related benefit, including reducing pain (see pages 200-205). Infusion is one of the

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common forms of oat straw composition well employed (page 200). Note, ordinary skill in the art would understand that infusion is liquid product obtained by infusing, and infuse mean to steep or soak in order to extract soluble elements or active ingredient (see dictionary definitions of "infusion" and "infuse," American Heritage Dictionary).

3. Weed does not teach expressly to make water extract of oatstraw as herein claimed, or the addition of glycerin and lavender oil, as well as weight percentages of the same and teaching of a process for preparing a composition by addition of the components.

4. However, Puchalski teaches shampoo and bath and shower gels. Puchalski teaches that a polyol to enhance skin feel may be present in the compositions, including glycerin (see col. 3, lines 22-32). Jakobson teaches the addition of oils such as lavender oil in order to impart a medicinal activity to the composition in that the oil exert a relieving or healing action on the human body and/or exhibit a therapeutical activity by means of relaxing, refreshing, or vitalizing effect.

5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a water extract (infusion, or tincture) and combined with glycerin in order to benefit from the enhanced skin feel imparted by glycerin as taught by Puchalski and by the addition of lavender oil in order to benefit from the relieving or healing action of lavender oil as taught by Jacobson.

6. One of ordinary skill in the art would have been motivated to make a water extract (infusion, or tincture) because oatstraw are known to provide many health related benefit and the active ingredients are soluble in water. With respect to the weight percentages of the components, differences in concentration will not support the patentability of subject matter

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encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable range by routine experimentation. *In re Aller* 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). With respect to the claimed process for preparing the composition, the process involves combining the recited components. It is the position of the examiner that a process for preparing a composition which merely the process of combining the components is render obvious by the composition itself. With respect to the limitation of "magnetically treated water," note the employment of magnetically treated water for preparing therapeutical composition would have been obvious in view of Ito, or Patrasenko et al. Ito, or Patrasenko et al teach magnetic treatment provide cleaner water. See column 1, lines 45-67 in Ito and the abstract of Patrasenko et al. It would have been obvious to one of ordinary skill in the art to using clean water to make therapeutical composition.

(10) Response to Argument

Appellants essentially made two arguments:

A) Whether the removal of residue by filtering in oatstraw extract would have been obvious over Weed's teaching;
and B) Whether the limitation "magnetically treated water" would distinguish the claimed invention from the cited prior art.

It would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make an oatstraw extract without the residue.

Weed teaches hot water extraction of oatstraw (see page 205). The extracts are in the form of oatstraw baths. Weed states "use an oatstraw footbath to soak away stink, sweat, cold,

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and pain from your tender tootsies," (page 205). Weed teaches the use of aqueous extracts of oatstraw applied externally to treat pain from any internal distress, including uterine pain. For purposes of examination, uterine pain is considered to meet the limitation of menstrual cramps. Weed also teaches the use of the extract for treating *skin diseases, flaky or dry skin, wound, and eye irritations*. Weed further teaches that it is well known that oat straw provide many health related benefit, including reducing pain (see pages 200-205). *Infusion is one of the common forms of oat straw composition well employed (page 200)*. Note, ordinary skill in the art would understand that infusion is liquid product obtained by infusing, and infuse mean to steep or soak in order to extract soluble elements or active ingredient (see dictionary definitions of "infusion" and "infuse," American Heritage Dictionary).

Appellants concede that "oatstraw extract and method of preparation and use of the same," including "steeping the oatstraw in heated water." "are well known to anyone skilled in the art..." (Summary of claimed subject matter at page 2 of the appeal brief). However, with respect to Weed's teaching, appellants focus on the particular example, and ignore the general teaching and the knowledge generally available to one of ordinary skill in the art. Particularly, appellants assert that Weed teach against filtering since Weed particularly states (Yes, with the oats and all.), (page 205). Question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278.

Further, it is well settled that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi,

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440 F.2d 442, 169 USPQ 423 (CCPA 1971). Therefore, one of ordinary skill in the art would have not considered the statement “(Yes, with the oats and all)” as a teaching away from removal of the residual. In conclusion, it would have been *prima facie* obvious to make a heated water extract of oatstraw without oatstraw residue for treating disorders as taught by Weed, such as skin diseases, flaky or dry skin, wound, and eye irritations.

The limitation “magnetically treated water” fails to distinguish the claimed invention from the prior art.

Claim Construction As it is understood that during examination, claims are given their broadest reasonable interpretation. See *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). “Water” recited herein is construed as encompassing composition consisting of water molecules (distilled water, deionized water) and composition consisting essentially of water, but with limited amounts of minerals dissolved in it, such as tap water, spring water etc. Therefore, the “magnetically treated water” would read on magnetically treated distilled water or magnetically treated deionized water. One of ordinary skilled artisan, could not comprehend the difference between magnetically treated water molecules and non-treated water molecules. Therefore, the “magnetically treated water” is not distinct from water. It is well-settled that if the product in the claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

With regard to other issue US patents, the examiner maintains that an issued US patent is a property, not a precedent. The examiner should not, and will not make any comment about issued US patent.

The examiner maintains that appellant fails to provide convincing evidence showing magnetized water is different from un-magnetized water. Appellants have compared magnetically treated "water" with deionized water. Such comparison lack probative force as the "water" contains minerals components. It cannot be conclude that the observed difference is due to the change of "magnetized" water molecules.

Appellant's declaration, and the declaration by Richard Green submitted September 3, 2004 have been fully considered, but are not persuasive.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., minerals in water) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicants argue that "magnetically treated water" is distinct from deionized water and provides unexpected benefit. Both the declarations are trying to prove this position. However, the claims as pending do not require the presents of minerals. Further, it would have been well-understood that the mineral content in water would vary widely depending on the sources of water. There is no information as to the initial mineral contents in untreated water.

Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 must compare the claimed subject matter

with the closest prior art in order to be effective to rebut a prima facie case if obviousness. See, MPEP 716.02 (e). Appellant fails to present a prima facie case of unexpected benefits commensurate in the scope of claimed invention.

8. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The citing of Ito and Patrasenko is merely to show that magnetic treatment of water is well-known in the art and would have been obvious to one of ordinary skill in the art to use such process for a cleaner water. Take the cited references as a whole, the claimed composition and process would have been obvious as discussed above.

The examiner further contend that, the employment of magnetically treated water for preparing therapeutical composition would have been obvious in view of Ito, or Patrasenko et al. Ito, or Patrasenko et al teach magnetic treatment provide cleaner water. See column 1, lines 45-67 in Ito and the abstract of Patrasenko et al. It would have been obvious to one of ordinary skill in the art to using clean water to make therapeutical composition. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Other issues

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, and motivation are found both in the cited reference and in the knowledge generally available to one of ordinary skill in the art. Particularly, Weed teaches the usefulness of oatstraw water extract for topical application, for soothing pain, inflammation, and various healthy benefits. Puchalski et al. teaches the usefulness of glycerin in topical application. Jakobson teaches lavender oil is useful in bath additive for relieving or healing action on the human body and/or exhibit a therapeutical activity by means of relaxing, refreshing, or vitalizing effect. It is *prima facie* obvious to combine two or more ingredients each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose (herein topical application, e.g., bath); idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination known ingredients of topical application sets forth *prima facie* obvious subject matter. See *In re Kerkhoven*, 205 USPQ 1069. As to the particularly combination herein, note the employment of the particular emollient (glycerin), and oil (lavender oil) is seen to be a selection from amongst equally suitable material and as such obvious. *Ex parte Winters* 11 USPQ 2nd 1387 (at 1388). In summary, Weed teaches the

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beneficial properties of oatstraw (see the entire document of Weed), therefore, employ oatstraw water extract with other well-known topical, beneficial ingredients in a well-known topical application form, and the method of using the same is obvious to one of ordinary skill in the art. Further, Weed provides no teaching or suggestion that the particular method disclosed therein is the only method for employ oatstraw. One of ordinary skill in the art would understand that oatstraw contains beneficial ingredients, and would have been motivated to employ oatstraw in method other than those expressly disclosed by Weed.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, one of ordinary skill in the art would have known to remove the residue of the oatstraw for reasons discussed above. Particularly, note it would have been obvious to one of ordinary skill in the art at the time the invention was made, that most of the active ingredients of oatstraw would have been extracted into water when "extracted with boiled water." Therefore, using water extract only by filtering out the residues is an obvious alternative of keeping the residue in the water extract, especially when a commercial extract is made. Weed does not teach against filtering. What Weed taught is a particularly situation, wherein the extract is made *in situ*. What Weed is saying is that it is not necessary to remove the residue.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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